

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Patent No.: 7,352,353
Issued: April 1, 2008
Application No.: 10/729,044
Applicants: Albert et al.
Confirmation No.: 9323
Filed: December 5, 2003
Group Art Unit: 2674
Examiner: Lewis, David Lee

Attorney Docket No.: INK-029C1
Customer No. 26245

Cambridge, Massachusetts
June 2, 2008

APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 CFR 1.705(d)

Mail Stop Patent Term Adjustment
Commissioner for Patents
P.O. Box 1450
Alexandria VA 22313-1450

Sir:

Pursuant to 37 CFR 1.705(d), patentees hereby request reconsideration of the Patent Term Adjustment (PTA) of 239 days stated on the face of the above patent. More specifically, applicants contend that the aforementioned PTA should be increased by 175 days for a total of 414 days, because two delays of 55 and 120 days charged to the applicants subsequent to the Notice of Allowance are not justified under the Rules.

The relevant facts concerning this application can be summarized as follows. The Notice of Allowance indicated a PTA of 348 days calculated (according to the IFW, which the undersigned attorney has reviewed in detail) as 417 days Office delay in issuing the Office Action of March 29, 2006 less 41 days for the Extension of Time filed August 9, 2006 and 28 days for the Extension of Time filed February 28, 2007. Applicants agree with this calculation and concede that the PTA of 348 days stated on the Notice of Allowance was correct as of the date the Notice of Allowance was issued.

The IFW also shows PTO delays of 41 days as of March 12, 2008 and 25 days as of April 1, 2008, and again patentees do not dispute these periods. However, patentees do dispute the 55 day delay charged to them on October 2, 2007 and the 120 day delay charged to them on November 26, 2007. The former delay results from the filing by patentees of a Request for Clarification of the Notice of Allowability pointing out that the Notice of Allowance referred to an Examiner's Statement of Reasons for Allowance but that no such Statement was mailed. The latter delay results from the filing by patentees of a Notification of Missing Fee, advising the Office that they had failed to charge an extension fee previously authorized by applicants.

The only possible basis for charging the patentees with these two periods of delay appears to be 37 CFR 1.704(c)(10) governing the filing of Rule 312 Amendments and other papers after a Notice of Allowance. Firstly, it is respectfully submitted that this Rule was never intended to cover the filing of papers (such as the two papers at issue here) which simply point out mistakes in the IFW caused by the Office. It is unjust that patentees should be penalized in patent term simply for attempting to remove from the record errors due to the Office. Alternatively, it is submitted that under the wording of 37 CFR 1.704(c)(10) itself, no delay is chargeable. This Rule in effect provides that when a Rule 312 Amendment or other paper is filed after a Notice of Allowance, the PTA shall be reduced by the *lesser* of the period from the date of filing of the Rule 312 Amendment or other paper and ending on the date of the Office response thereto, or four months. There was no response by the Office to either of the post-allowance papers filed by the patentees, and hence by the plain terms of 37 CFR 1.704(c)(10), no delay should be charged. Furthermore, 37 CFR 1.704(c)(10) does not authorize charging for the number of days between the Notice of Allowance and the submission of the relevant paper (which is the basis on which the 55 and 120 day periods appear to have been calculated), only the number of days between the submission of the paper and the Office response.

Finally, it is respectfully submitted that even if, contrary to the patentees' submissions above, some delay should be charged to patentees as a result of their post-

Patent No. 7,352,353
Application for PTA, May 29, 2008
Page 3

allowance filings, it is entirely unfair to charge both the 55 and 120 days delay to the patentees. Where, as here, one paper is filed 55 days after the Notice of Allowance and another 120 days after the Notice, one cannot logically count both periods in full, since this double counts the initial 55 day period.

For all the foregoing reasons, the patentees request that the PTA of the above patent be increased to 414 days.

The fee prescribed in 37 CFR 1.18(e) for the filing of this application is paid herewith.

Respectfully submitted
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